

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/19/08 have been fully considered but they are not persuasive.

Applicant argues (9/18/08 Response: page 2, line 3 - page 3, line 7) that Examiner's combination of Micrografx and Tone is based on impermissible hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues (9/18/08 Response: page 3, lines 8-21) that Tone teaches a mark selecting means for selecting a mark from a predetermined database of marks, and that the Office Action fails to show why one of ordinary skill in the art would modify the design of Tone to include the Micrografx arrangement for selecting and adding a mark.

However, as noted by the outstanding Final Rejection, the suggestion/motivation for applying Micrografx to Tone is precisely to allow the use of a wide range of image processings (as taught by Micrografx) to an image scanning and forming device (as taught by Tone). The specific argument related to the limited range of marks available in Tone is an example of analysis based on a single reference of a combination. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues (9/18/08 Response: page 3, line 22 - page 4, line 2) that claims 1 & 20 are allowable for the above reasons, and that dependent claims 2-6, 8, 15, 19, & 22-26 are allowable at least for their respective dependencies (from claims 1 or 20, as the case may be), as well as for the separately patentable subject matter each of these claims recites.

Applicant's arguments re claims 1 & 20 have been addressed above.

Re dependent claims 2-6, 8, 15, 19, & 22-26, the argument that they are allowable by virtue of the allowability of their parent claims has been addressed above with respect to claims 1 & 20. The argument that they are allowable for separately patentable subject matter recited in these claims amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

2. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application, entry of papers into this application, or other any inquiries of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 571-272-1000.

The examiner can normally be reached on weekdays 8:00-5:30, alternate Fridays off.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Art Unit: 2625

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300.

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

/S. M. B./

Examiner, Art Unit 2625

/Thomas D Lee/

Primary Examiner, Art Unit 2625